

Appl. No. 10/541,330
Amendment Dated July 23, 2009
Reply to Office Action of April 7, 2008

...REMARKS...

The present Supplemental Amendment limits the polymerizable monomer free of fluorine atoms in claim 4 to "at least one of (meth)acrylic acid ester, dialkyl ester of fumaric acid or maleic acid and vinyl ester."

Entry of this change to the claims is respectfully requested.

The Office Action of April 7, 2008 has been thoroughly studied. Accordingly the changes presented herein for the application, considered together with following remarks, are believed to be sufficient to overcome the outstanding rejection of the claims and place the application into condition for allowance.

Claims 1-6, 8-10 and 15 are pending in this application.

On page 2 of the Office Action the Examiner has rejected claims 1-6, 8-10 and 15 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Under this rejection the Examiner has taken the position that in claim 1, line 4 the recitation "nonionic surfactant comprising a condensation product of polyethylene oxide (n=10-90) and octyl phenol or nonyl phenol" is not described in the original specification.

The Examiner takes the position that the recitation of "nonionic surfactant comprising a condensation product of polyethylene oxide (n=10-90) and octyl phenol or nonyl phenol" is "new matter" in the application.

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Applicants submit that the recitation of “nonionic surfactant comprising a condensation product of polyethylene oxide (n=10-90) and octyl phenol or nonyl phenol” is found in international application PCT/JP2004/000459 and is therefore not new matter for at least the following reasons:

Reason 1:

MPEP 2163.07 provides, in part, that

An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction.

In the present situation the typographical or clerical which resulted in the recitation of “a condensation product of polyethylene oxide (n=10-19)” on page 6 of applicants’ specification is clearly not commensurate with the examples which recite (on page 9) “Polyethylene (n : 30) mono(nonylphenyl) ether” and “Polyethylene (n : 50) mono(nonylphenyl) ether.”

These recitations clearly indicate that there is an “obvious” error in the recitation of “a condensation product of polyethylene oxide (n=10-19)” on page 6 of applicants’ specification.

Once one skilled in the art would recognize this “obvious” error, the only “appropriate correction” is that of “a condensation product of polyethylene oxide (n=10-90)” found in the Japanese text of applicants’ original international PCT application.

Reason 2:

MPEP 2163.07 states, in part, that:

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Where a foreign priority document under 35 U.S.C. 119 is of record in the U.S. application file, applicant may not rely on the disclosure of that document to support correction of an error in the pending U.S. application.

It is important to note that in the present situation, the International PCT application PCT/JP2004000459 is the actual application that is filed in the United States when the International PCT application is nationalized in the United States.

That is, the nationalized United States application Serial No. 10/541,330 does not claim "foreign" priority to the International PCT application under 35 U.S.C. §112, but rather domestic/National stage priority under 35 U.S.C. §120.

Therefore the inability to rely upon the disclosure in a document to which "foreign" priority is claimed for correcting an error (as set forth in MPEP 2163.07) **does not apply**.

There is no provision which presents applicants from relying upon the text of the International PCT application PCT/JP2004000459, from which domestic/National stage priority is claimed under 35 U.S.C. §120.

Reason 3:

As indicated on the "TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A SUBMISSION UNDER 35 U.S.C. 371," applicants filed "An English language translation of the International Application as filed (35 U.S.C. 371(c)(2))."

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Thus, applicants were prohibited from making any changes from the disclosure of the International Application, when submitting an English language translation of the International Application.

Accordingly, applicants are entitled to rely upon the text of the International Application to correct any translational, typographical or clerical errors in the translated application.

If any "new matter" issues should have been raised, the Examiner himself should have question how the range of "(n=10-90)" ended up being translated to "(n=10-19)."

For any one and all of the above reasons, it is submitted that the amendment to change "(n=10-19)" to --(n=10-90)-- in the specification and to further recite --(n=10-90)-- in claim 1 does not involve any new matter.

Rather these amendments conform the application to the International PCT Application.

Submitted herewith as Exhibit "A" is a color coded comparison of corresponding portions of applicants' PCT application (original Japanese text), the English translation of applicants' priority document (filed January 10, 2008) and applicants' original English specification.

For reference, the corresponding recitations of "alkylamines of C₁₂ to C₁₈" have been highlighted in yellow and framed in boxes.

The corresponding recitations concerning the "condensation product of polyethylene oxide" have been highlighted in green.

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As can be seen the original U.S. (English) specification included the recitation of "(n=10 to 19)" whereas applicants' PCT application (original Japanese text) included the recitation of "(n=10~90)."

The priority document did not include a comparable recitation, but is included to confirm that the highlight text concerns the "condensation product of polyethylene oxide."

The undersigned telephoned the Examiner upon receiving the Advisory Action of August 29, 2008 and reading where the Examiner stated:

Since applicants fail to provide a copy of PCT/JP2004/000459, the Examiner turns to the foreign priority document JP 2003-018169. After reading both JP 2003-018169 and the the originally filed specification of 7/1/2005, the Examiner has to maintain the 112 rejection set forth because applicants' argument relating to the "new matter" rejection is not adequately supported by the evidence. (underlining added)

Submitted herewith is a copy of PCT/JP2004/000459 which the undersigned printed from the file wrapper of the present application off the USPTO website. When discussing this document on the telephone with the Examiner, the Examiner explained that he did not have a copy of this document in his file at the USPTO.

It is submitted that upon receipt of a copy of PCT/JP2004/000459 and Exhibit A, the Examiner can confirm that PCT/JP2004/000459 supports the recitation of "(n= 10-90)" and the outstanding new matter rejection should properly be withdrawn.

Claims 1-6, 8-10 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,387,292 to Saito in view of U.S. Patent Application Publication No. 2003/0114547 to Hara et al.

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The Examiner has relied upon Saito as disclosing:

...a process of preparing an anti-soil composition in the form of an aqueous dispersion comprising a fluoroalkyl group-containing monomer with a polymerizable monomer free of fluorine atoms, and polypropylene glycol having an average molecular weight of not more than 1,000. Saito (col. 2, line 12-13) disclose a C₁₂-fluoroalkyl group containing monomer. Saito (col. 3, line 10-20) disclose a list of polymerizable monomers that include cyclohexyl (meth)acrylate, benzyl (meth)acrylate, stearyl (meth)acrylate, acrylamide. The disclosed stearyl (meth)acrylate of Saito (col. 3, line 10-20) generically include stearyl acrylate in view of claim 2 of Saito, where a (meth)acrylate ester also includes an acrylate ester. Saito clearly indicate using a polymerization initiator (col. 4, line 67), and surfactants (col. 5, line 65 to col. 6, line 7). Saito (col. 4, example 1) disclose a formulation comprising at least 10 wt% of polyfluoroalkyl groups. Saito et al. (col. 6, line 8-12) describe the process of preparing an aqueous dispersion comprising water.

Regarding the claimed non-ionic surfactant, Saito (col. 5, line 65 to col. 6, line 3) clearly disclose the use of non-ionic surfactants based upon polyethylene glycol and octyl or nonyl phenol.

The Examiner has relied upon Hara et al. as disclosing:

...a process for preparing a dispersion of fluorine-containing polymer. Further, Hara et al. (page 2, 0036-0038) clearly teach the combination use of different types of surfactants, which includes cationic surfactants (page 2, 0037) and nonionic surfactants (page 2, 0038) as claimed.

In combining the teachings of Saito and Hara et al. the Examiner takes the position that:

...it would have been obvious....to incorporate the combination use of cationic surfactants and non-ionic surfactants as taught by Hara et al. into the Saito to obtain the invention of claims 1-6, 8-10, 15.

On page 5 of the Office Action of April 7, 2008 the Examiner states:

In view of the 112 rejection set forth for the introduction of "new matter" into the claims, the instant rejection [under 35 U.S. C. 103(a)] is proper.

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Further on page 2 the Examiner states:

Although applicants argue that the newly recited feature is supported by a document "WO2004/067579 A1", the examiner still could not find the support in the English translation document filed January 10, 2008 for WO2004/067579 A1. Therefore, the 112 rejection set forth October 9, 2007 is proper.

The Examiner should note that the disclosure of applicants' Japanese priority document filed January 10, 2008 has no bearing on the "new matter" issues raised by the Examiner.

The reasons are as follows:

First, it is not uncommon for applicants to vary specifications when filing a PCT International Application. That means that the disclosure of the priority document(s) for a PCT International Application may not be the same as the disclosure of a corresponding PCT International Application.

Thus, the fact that the Examiner cannot find support for the recitation of "(n=10-90)" in applicants' English translation of the Japanese priority document filed January 10, 2008 has no bearing on the "new matter" issues raised by the Examiner.

Second, as noted above, support for the recitation of "(n=10-90)" is found on page 6 of applicants' originally filed (and published) International PCT Application No. PCT/JP2004/000459.

This support is proper inasmuch as it is an English translation of International PCT Application No. PCT/JP2004/000459 which is U.S. Patent Application Serial No. 10/541,330.

Regardless of the "new matter issue" raised by the Examiner and addressed by applicants above, it is noted that, in reference to Saito the Examiner has stated:

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Regarding the claimed non-ionic surfactant, Saito (col. 5, line 65 to col. 6, line 3) clearly disclose the use of non-ionic surfactants based upon polyethylene glycol and octyl or nonyl phenol.

It is important to note that the portion of Saito which the Examiner has relied upon (column 5, line 65 to column 6, line 3) concerns Comparative Example 3 in which the polypropylene glycol (a teaching in Saito the Examiner relied upon) was replaced with the commercial surfactants (Emulgen 950 and Emulgen 930). As noted, the Polymerization reaction product gelled so that it did not produce an aqueous dispersion.

If anything, Saito teaches against the use of surfactants by way of Comparative Example 3.

So it follows that it would go against the teachings of Saito to incorporate the surfactants of Hara et al. as the Examiner suggests and purports to be obvious.

Thus the combination of Saito and Hara et al. is not obvious.

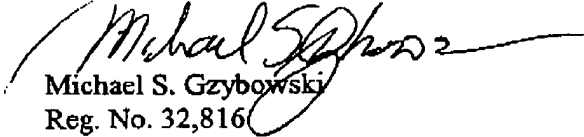
If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of

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time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,


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